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## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

51

Application Number	10/628,963
Filing Date	July 29, 2003
First Named Inventor	Richard W. Nykamp
Art Unit	1772
Examiner Name	Catherine Simone
Attorney Docket Number	076764.083552

### ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences  <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Appeal Brief Fee \$250
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Remarks

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Warner Norcross & Judd LLP		
Signature	<i>Charles E. Burpee</i>		
Printed name	Charles E. Burpee		
Date	February 27, 2006	Reg. No.	29 776

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Signature	<i>Charles E. Burpee</i>		
Typed or printed name	Charles E. Burpee	Date	February 27, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Examiner : Catherine A. Simone  
Art Unit : 1772  
Applicant : Richard W. Nykamp et al  
Serial No. : 10/628,963  
Filing Date : July 29, 2003  
For : COVER FOR METAL OFFICE FURNITURE  
Attorney Docket : 076764.083552

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Alexandria, VA 22313-1450

### APPEAL BRIEF

This is an appeal from a final rejection of claims 1, 3, 11-12, and 17-19 by  
Examiners Simone and Pyon.

#### I. Real Party In Interest

The real party in interest is The R & D Companies, LLC of 3400 Highland Drive,  
Hudsonville, Michigan 49426.

#### II. Related Appeals and Interferences

Appeal No. 2005-1709 was decided in Appellant's favor in parent Application  
No. 09/999,400. That appeal is related to, directly affects, and has a bearing on the Board's  
decision in the pending appeal. A copy of the decision rendered by the Board in that appeal is  
included in the Related Proceedings Appendix X.

For the Board's convenience, the following is a mark-up of pending claim 17

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showing the differences from the independent claim allowed in the previous appeal:

17. An article of office furniture comprising:

a metal office furniture piece including a plurality of components each having dimensions[, one of said components including a physical feature]; and

a plurality of magnetic decorative covers, each of said covers overlying and attached to one of said components, each of said covers having dimensions substantially the same as the dimensions of the component to which the cover is attached, each of said covers comprising a magnetic sheet and a decorative material selected from the group of fabric, vinyl, leather, veneer, and laminate[, the decorative cover attached to said one component defining a cutout aligned with said physical feature].

Claim 11 defines the method that creates the office furniture article defined in claim 17. Claim 12 defines the method that creates the office furniture article defined in the independent claim allowed in the previous application. Claim 1 defines a single cover of the type (a) included in the office furniture article of the claim allowed in the previous application or (b) as used in the method of claim 12.

The Appellant regrets that the Board must consider this highly related subject matter in two separate appeals. In the previous (original) application, Examiner Simone stated that she would allow certain claims if the presently appealed claims were re-filed in a continuation application. Accordingly, the Appellant filed this continuation application; and the

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Appellant expected an allowance in the original application. However, the agreement (regarding the allowance of the claims in the original application) was withdrawn at Examiner Pyon's direction. And the two applications continued their duplicate lives leading to duplicate appeals.

There are no other related appeals or interferences known to the Appellant, the Appellant's legal representative, or the Appellant's assignee which may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

### III. Status of Claims

Claims 1, 3, 11-12, and 17-19 are pending and are finally rejected. Claims 2, 4-10, and 13-16 are canceled.

### IV. Status of Amendments

No amendment has been filed subsequent to the final rejection.

### V. Summary of Claimed Subject Matter

#### A. Background of the Invention

Metal office furniture is one of the backbones of the office environment. Exemplary pieces include file cabinets, desks, and drawer pedestals. Metal office furniture is fabricated of steel and then painted, making it both functional and durable.

Several negative issues are related to metal office furniture. First, the appearance

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of such furniture typically is regarded as tolerable rather than attractive. For example, a large bank of filing cabinets presents a sea of uniform color, such as beige or gray.

Second, the colors with which the furniture is painted go out of style. To change color, it is necessary either to purchase new furniture or to repaint existing furniture. The first option is undesirably expensive, and the second option is undesirably inconvenient.

Third, the finishes of metal furniture occasionally become scratched or otherwise marred, so that they are unsightly. In such cases, it is necessary to replace the furniture (or at least the damaged components) or to repaint the furniture (or at least the damaged components).

Fourth, when additional or replacement office furniture is purchased, one challenge is matching the color of the new office furniture to the existing furniture. The new office furniture may be made by a different manufacturer offering different colors, or may be made by the same manufacturer no longer offering the old color. Even if a color is still made by the previous manufacturer, the new office furniture may not match the existing furniture due to fading, different dye runs of paint, or changes in the manufacturing process, such as switching from a wet paint to a powder coat.

B. Claimed Subject Matter

The present invention is a system for dramatically changing the appearance of office furniture in a simple and relatively inexpensive way. The dramatic change enabled by the present invention is illustrated in the brochure entitled "Change is Good!" published by the Appellant and attached to this Appeal Brief as part of the Evidence Appendix IX. When the

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brochure is fully open, the left side shows the "Before" appearance of conventional painted office furniture. The right side shows the "After" appearance in which the decorative covers of the present invention are applied to the flipper doors and drawer fronts (and in which tack-boards and cushions also are included on other furniture components).

As defined in claim 17, the present invention is "an article of metal office furniture" comprising a metal office furniture piece 100 and a plurality of magnetic decorative covers 10. As illustrated in Figs. 1-2 and described in the specification (page 4, lines 10-22), the furniture piece is a filing cabinet. The cabinet 100 includes a plurality of components such as the drawer fronts 110. Other components include the side panels 120 and the base 130. Each of the components has dimensions. Each of the covers 10 overlies and is attached to one of the drawer fronts 110 or other component with each cover 10 having dimensions substantially the same as the dimensions of the component to which it is attached, so that each cover substantially covers the drawer front or other component. (Page 4, lines 16-22.) The covers 10 each include a decorative layer 20 attached to a magnetic sheet 40. (Fig. 2; page 3, line 8 through page 4, line 9.)

As defined in claim 11, the present invention is "a method for altering the appearance of a metal office furniture article." The method of claim 11 produces the furniture piece or article of claim 17. The method comprises providing a magnetic cover 10 for each of the plurality of components 110, 120, or 130 in which each cover has dimensions substantially the same as the dimensions of the corresponding component; aligning each cover with the corresponding component; and allowing each aligned cover to magnetically adhere to the

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corresponding component. (Page 4, lines 16-22 and page 6, lines 18-21).

As defined in claim 1, the present invention is “a decorative cover for a metal office furniture component having a physical feature.” As such, claim 1 defines a specific variation of the cover in which a decorative layer is laminated to a magnetic sheet; the lamination is dimensioned to cover the component substantially completely; and the lamination defines an aperture positioned to be aligned with the physical feature when the lamination is mounted on the furniture component.

#### VI. Grounds of Rejection To Be Reviewed on Appeal

Claims 17-19 are finally rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent 5,799,423 to Malino (“Malino”) in view of U.S. Patent 5,158,324 to Flesher (“Flesher”).

Claims 1, 3, and 11-12 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Flesher.

#### VII. Argument

##### A. The Section 103(a) Rejection of Claims 17-19 Over Malino and Flesher

The rejection of claims 17-19 under 35 U.S.C. 103(a) on the hypothetical combination of Malino and Flesher is improper and/or unfounded, and should be reversed.

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1. Malino and Flesher and Their Individual Shortcomings

Malino discloses a magnetic calendar 20 that can be attached to a metal filing cabinet. The calendar covers only a portion of the side of the filing cabinet. As previously noted by the Board on page 3 of its attached previous decision:

- “Malino’s calendar is not disclosed as having dimensions substantially the same as those of the component to which it is attached. . . . In fact, the calendar shown in Figures 2 and 6 have substantially smaller dimensions than those of the component to which it is attached.”
- “As also recognized by the examiner, Malino discloses only a single calendar, not a plurality of magnetic decorative covers each overlying and attached to one of the components.”

Malino does not remotely suggest -- let alone disclose or teach -- the features of the present invention as defined in claim 17. First, Malino does not suggest a plurality of covers each overlying and attached to a furniture component. Second, Malino does not disclose a single cover -- let alone a plurality of covers -- having dimensions substantially the same as the dimensions of the component to which the cover is attached. These shortcomings are not surprising because Malino does not recognize -- let alone address -- the issue of the appearance of metal office furniture.

Flesher discloses “a protective cover for vehicles.” The “cover” is a plurality of pieces that can be mounted on the front of an automotive vehicle. Collectively, the Flesher pieces form a protective bug/stone screen for the vehicle. Although the Flesher pieces



incidentally change the appearance of a portion of the front end of the vehicle, the change is incidental to the protective feature. The hood piece covers only a portion of the hood, and the fender pieces each cover only a portion of each fender.

The Examiners assert that “Flesher clearly teaches magnetic covers each having dimensions substantially the same as the dimensions of the corresponding component (see Figs. 2A-2F and Fig. 1, elements 100).” However, only the two headlight cover segments 40 and 41 entirely cover the underlying component. The other eight cover segments (32 in Fig. 2A; 34 and 36 in Fig. 2E; 38 and 39 in Fig. 2C; 42 in Fig. 2B; and 44 and 45 in Fig. 2F) all are substantially smaller than the components to which they are attached. The segments 40 and 41 cover their components only incidentally or accidentally because the headlight covers lie entirely within the area to be protected. It is not the intention or goal of Flesher to cover any component entirely.

Flesher does not suggest, let alone disclose or teach, the features of the invention as defined in claim 17. First, Flesher is not an article of office furniture. Second, Flesher does not disclose a metal office furniture piece including a plurality of components each having dimensions. Third, Flesher does not disclose a plurality of decorative covers each of which overlies and is attached to one of the components, and each of which has dimensions substantially the same as the dimensions of the component to which the cover is attached.

## 2. Malino and Flesher Are Not Properly Combinable

It is well settled that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or

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incentive supporting the combination. ACS Hospital Systems, Inc. v Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). There simply is no teaching, suggestion, or incentive supporting the combination fashioned by the Examiners in hindsight. Specifically, there is no suggestion in either reference, or in either art, to combine one of the references with the other.

Flesher is similar to U.S. Patent 6,217,958 to Blyden discussed by the Board at page 4 of its attached previous decision. The Board's following observations regarding Blyden are equally applicable to Flesher.

- "Blyden [as well as Flesher] is in no way directed to office furniture."
- "Accordingly, Blyden [as well as Flesher] would not have provided any suggestion to one of ordinary skill in the art to modify the dimensions of the calendar of Malino to substantially correspond to those of the component of furniture to which it is attached."

Flesher cannot be combined with Malino for the same reasons that Blyden cannot be combined with Malino.

Further, neither Malino nor Flesher recognizes, let alone attempts to resolve, the problem overcome by the present invention (i.e. changing the appearance of office furniture).

Indeed, the only motivation for proposing a combination of Malino and Flesher is an improper attempted hindsight reconstruction using the present specification as a roadmap. Such an approach is impermissible.

Therefore, the Section 103(a) rejection of claims 17-19 is improper and should be reversed because the references are not combinable.

3. Even When Improperly Combined, Malino and Flesher Do Not Disclose, Teach, or Suggest the Present Invention

Even the improper combination Malino and Flesher does not teach the invention as defined in independent claim 17. Specifically, the improper combination does not teach an article of office furniture having multiple components each covered by a decorative cover having dimensions substantially the same as the respective component.

Therefore, for this second independent reason, the Section 103(a) rejection of claims 17-19 is improper and should be reversed.

B. The Section 102(b) Rejection of Claims 11-12 Over Flesher

The rejection of claims 11-12 under 35 U.S.C. 102(b) as being anticipated by Flesher is improper and should be reversed.

Flesher does not disclose the recitations of independent claim 11. First, Flesher has nothing to do with “A method for altering the appearance of a metal office furniture article.” To the contrary, Flesher shows a method for protecting the front end of a vehicle. Second, Flesher does not disclose “each cover having dimensions substantially the same as the dimensions of the corresponding component.” To the contrary, this recitation is met by only two of the ten Fletcher cover segments, and even then only because those covers accidentally lie within the area to be protected. Third, and related to the second point, the pieces of the Flesher cover do not “substantially cover the entire component” to which they are attached.

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The Examiners have not given patentable weight to the recitation “altering the appearance of a metal office furniture article” in method claim 11, stating that, “A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process . . . and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps . . . are able to stand alone.” The Examiners’ statement is correct but inapplicable to claim 11. The claim language in question does not merely recite the purpose of the process. Rather, it recites the process itself. Further, the body of the claim depends on the preamble for completeness. Specifically, each step in the claim makes sense only in the context of the claimed method of “altering the appearance of a metal office furniture article”. The cases cited by the Examiner therefore support Appellant’s position – not the Examiners’ position.

Further, as noted in Catalina Marketing International Inc. v. Coolsavings.com, Inc., 289 F.3d at 808-09, 62 U.S.P.Q.2d 1781, 1785 (Fed. Cir. 2002), “Clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention.” As it continues to do in this Brief, Appellant has relied throughout prosecution on the preamble language in question to distinguish the claimed invention from the prior art.

Yet further, the body of claim 11 repeated refers back to the preamble. For example, each of the three steps recited in the claim refer to the “components” recited in the preamble. Frankly the claim does not make sense without the entire preamble.

For the foregoing reasons, the claim 11 preamble language in question must be

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given patentable weight.

In view of the shortcomings of Flesher with respect to claim 11, including the entire preamble, the rejection of claims 11-12 is improper and should be withdrawn.

C. The Section 102(b) Claims 1 and 3 Over Flesher

The rejection of claims 1 and 3 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,158,324 to Flesher is improper and should be reversed.

Flesher also does not disclose the recitations of independent claim 1. First, Flesher does not disclose “a decorative cover for a metal office furniture component having a physical feature.” Second, Flesher does not disclose a cover that both (1) substantially covers the underlying component and (2) defines an aperture positioned in alignment with a physical feature of the underlying component.

The Examiners state, “The recitation ‘a decorative cover for a metal office furniture component having a physical feature’ has not been given patentable weight because the recitation occurs in the preamble.” The Examiners provide the same statements and the same case citations as provided in conjunction with claim 11. There simply is no support (cited or otherwise) for the Examiners’ broad proposition that preamble language cannot be given patentable weight. The quoted preamble language from claim 1 does not recite merely the intended purpose of the product, but rather defines the product itself. The claimed cover is not for anything other than an office furniture component having a physical feature. The claimed cover is not for anything else, such as automobiles. The claimed cover has no utility or

application beyond the definition included in the preamble. The Appellant has relied throughout prosecution (including this Brief) on the preamble language to distinguish the claimed invention from the prior art. Further, the above preamble arguments made in conjunction with claim 11 are applicable to claim 1. Therefore, the language in question must be accorded patentable weight.

The Examiners further state that “The cover of Flesher clearly defines an aperture (Fig. 2E, element 98) positioned to be aligned with a physical feature when the cover is mounted on a component (see column 2, lines 6-10).” The Appellant does not claim novelty in a hole. The Appellant points out that the claim language is much narrower. The claim defines specifically (1) a metal office furniture component cover (2) dimensioned to cover the component substantially completely and (3) defining an aperture positioned to be aligned with a physical feature on the component. While Flesher shows a hole in a different field of art, Flesher does not suggest the invention as defined in claim 1.

For all of the foregoing reasons, the Section 102(b) rejection of claims 1 and 3 is improper and should be reversed.

D. Secondary Considerations Support the Lack of Obviousness

The present invention has received widespread recognition within the contract furnishing industry (i.e. the office furniture industry). The invention has received a variety of national and state awards; and those awards have come from some of the most prestigious authorities in the contract furnishing industry. These awards include:

- 1) The “Best of NEOCON Gold Award” for the Surfacing Materials

category. The “Best of NEOCON” awards are the most prestigious and recognized awards in the contract furnishing industry, and are sponsored by *Contract Magazine*, the most highly regarding publication in the contract furnishing industry.

- 2) The “Grand Prize Innovation Award” for the Workplace Aesthetics category and the “Grand Prize Innovation Award” for the Workplace Productivity category. These “Building Interiors Magazine Innovation Awards” also are prestigious, and are sponsored by *Building Interiors Magazine*, a highly regarded publication in the contract furnishing industry. The present invention was the first product in the history of the awards to win back-to-back Grand Prizes.
- 3) “Honorable Mention” in the Small Business Innovation Awards in recognition of the most innovative products. These awards are made by the Small Business Association of Michigan.

The Declaration of Richard W. Nykamp discussing these awards is attached as Appendix IX.

The present invention also has received widespread media coverage. Copies of eight articles regarding the present invention are attached to Mr. Nykamp’s Declaration.

The Examiners assert that the Declaration is insufficient because “facts presented are not germane to the rejection at issue and showing is not commensurate in scope with the

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claims. It refers only to the system described in the above referenced application and not to the individual claims of the application. . . . See MPEP 716.” Although the Examiners have used form paragraph 766.03 from M.P.E.P. 716, they unfortunately have not complied with the Note 2 requirement that “A full explanation must be provided, if appropriate.” The Examiners have provided no explanation, let alone a full explanation, to supplement the form language. And while an explanation is required only “if appropriate,” an explanation is appropriate in the present application because the Appellant frankly cannot conceive of any explanation. The Declaration and attached evidence relate directly to the claimed subject matter. In fact, there are few differences between the claimed subject matter and the described apparatus and method. All of the facts, awards, and media coverage provide incredibly strong evidence both 1) of secondary considerations of nonobviousness and 2) that those skilled in the relevant art consider the present invention to be a significant development worthy of national and state awards. It therefore is respectfully submitted that the Declaration fully complies with the requirements of 37 C.F.R. 1.132 and M.P.E.P. 716.

These secondary considerations strongly support that the present rejections are improper, made in hindsight, and should be reversed.



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VIII. Claims Appendix

1. A decorative cover for a metal office furniture component having a physical feature, said cover comprising:

a magnetic sheet; and

a decorative layer laminated to said magnetic sheet to form a lamination dimensioned to cover the component substantially completely, said decorative layer selected from fabric, vinyl, leather, veneer, or laminate, said lamination defining an aperture positioned to be aligned with the physical feature when the lamination is mounted on the component.

3. The decorative cover as defined in claim 1 wherein said magnetic sheet is flexible.

11. A method for altering the appearance of a metal office furniture article having a plurality of components comprising the steps of:

providing a magnetic cover for each of the components, each cover having dimensions substantially the same as the dimensions of the corresponding component, each decorative cover having a decorative layer including at least one of fabric, vinyl, leather, veneer, or laminate;

aligning each cover with the corresponding component; and

allowing each aligned cover to magnetically adhere to the corresponding component to substantially cover the entire component.

12. The method as defined in claim 11 wherein said providing step includes providing at least one of the covers with a cutout aligned with a physical feature of the corresponding

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component when the cover is aligned with the component.

17. An article of office furniture comprising:

a metal office furniture piece including a plurality of components each having dimensions; and

a plurality of magnetic decorative covers, each of said covers overlying and attached to one of said components, each of said covers having dimensions substantially the same as the dimensions of the component to which the cover is attached, each of said covers comprising a magnetic sheet and a decorative material selected from the group of fabric, vinyl, leather, veneer, and laminate.

18. The article of office furniture in claim 5 wherein said magnetic sheet is flexible.

19. The article of furniture as defined in claim 5 wherein one of said decorative covers defines a cutout providing an aesthetic appearance such as a logo.

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IX. Evidence Appendix

Attached behind this page are copies of the evidence submitted pursuant to 37 C.F.R. 1.132. This evidence was attached as Appendix 2 to the Response filed September 15, 2005, and was entered in the record and considered by the Examiners as indicated on page 2 of the Final Rejection mailed December 7, 2005.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner : C. Simone  
Art Unit : 1772  
Applicants : Richard W. Nykamp et al  
Serial No. : 09/999,400  
Filing Date : November 15, 2001  
For : COVER FOR METAL OFFICE FURNITURE

Mail Stop Non-Fee Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

DECLARATION OF RICHARD W. NYKAMP PURSUANT TO 37 C.F.R. 1.132

Richard W. Nykamp declares and states that:

1. I am the President of The R & D Companies, LLC (R & D), the owner of the above identified patent application (the Application).
2. I have been involved in the contract furnishing industry (the Industry) for 30 years. During that period, I have developed considerable knowledge of contract furnishing products and innovations.
3. I am a named inventor in the Application. I am familiar with the content, including the specification and claims, of the Application. The Application discloses the product sold by R & D under the trademark FACEMENTS.
4. The FACEMENTS product has received widespread positive recognition in the Industry. In particular, the FACEMENTS product has won a number of national awards in the Industry.
5. The "Best of Neocon" awards are the most sought after and recognized awards in the Industry. The awards are sponsored by *Contract Magazine*, the most highly regarded publication in the Industry. The awards are presented annually in

conjunction with the Neocon World's Trade Fair.

6. The FACEMENTS product was awarded the "Best of Neocon Gold Award" in 2002 for the Surfacing Materials category. This award was the top award in the category. A copy of the award is attached as Exhibit A.

7. The "Buildings Interiors Magazine Innovation Awards" also are highly sought after recognized awards in the Industry. The awards are sponsored by *Building Interiors Magazine*, a highly regarded publication in the Industry.

8. The FACEMENTS product was awarded the "Grand Prize Innovation Award" in 2002 for the Workplace Aesthetics category. This award was the highest award in the category. A copy of the award is attached as Exhibit B.

9. The FACEMENTS product was awarded the "Grand Prize Innovation Award" in 2003 for the Workplace Productivity category. Again, this was the highest award in the category. A copy of the award is attached as Exhibit C.

10. The FACEMENTS product was the first product in the eight-year history of the "Buildings Interiors Innovations Awards" to win back-to-back grand prize honors.

11. The FACEMENTS product received honorable mention in the 2003 SBAM (Small Business Association of Michigan) Small Business Innovation Awards in recognition of the most innovative products introduced in 2002. A copy of the award is attached as Exhibit D.

12. The FACEMENTS product has received widespread coverage in the general press and in the contract furnishing press. Examples include the following articles, copies of which are attached as Exhibit E:

Grand Rapids Press

May 22, 2002

Monday Morning Quarterback	June 3, 2002
Buildings Interiors Magazine	August 2002
Surfacing Solutions Magazine	September 2002
FM Link (Facility Manager)	March 10, 2003 and May 16, 2003
Interiors Magazine	June 2003 Neocon Show Daily
Office Insight	June 9, 2003
Mi Biz West	June 30, 2003 and July 1, 2003

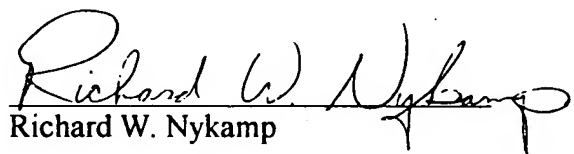
13. It is my understanding that the Patent Examiner has asserted that the FACEMENTS product is "obvious" in view of U.S. Patent 4,996,110 to Tanuma, which I have reviewed. I disagree with the Patent Examiner's assertion. In my opinion, the FACEMENTS product is not obvious in view of the Tanuma patent or any other prior art.

14. I believe that my opinion of nonobviousness is shared by others skilled in the Industry as evidenced by the awards and other recognition that the FACEMENTS product has received.

[The remainder of this page is intentionally blank.]

15. I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this application or any patent issuing thereon.

Date 7/25/03

  
Richard W. Nykamp

BEST AVAILABLE COPY

# 2003 INNOVATIONS Awards

## GRAND-PRIZE WINNER

in  
Workplace Productivity

Presented by  
**BUILDINGS** and **BI**

EXHIBIT C





## Small Business Association of Michigan

222 N. Washington Square, Suite 100  
P. O. Box 16158  
Lansing, Michigan 48901-6158

DESIGN AVAILABLE COPY

June 26, 2003

Rick Nykamp  
Facements  
3400 Highland Drive  
Hudsonville, Michigan 49426

Dear Mr. Nykamp:

Congratulations! I'm pleased to announce that you have been awarded an Honorable Mention Certificate from the 2003 Small Business Innovation Awards program in recognition of your innovative product, Facements.

A news release with a list of this year's winners was sent to news media statewide on June 26 and will also be posted on our Web site: [www.sbam.org](http://www.sbam.org)

The Awards, now in their ninth year, are sponsored by SBAM, the Small Business Foundation, Fifth Third Bank, *The Detroit News*, the Lansing Community College Small Business Development Center and the Michigan State University Office of Intellectual Property. The program gives recognition and publicity to the meritorious new products and services developed by Michigan-based small businesses during 2002.

Again, congratulations, and best wishes for the future of your innovative product.

Sincerely,

Michael W. Rogers, Vice President Communications

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# Honorable Mention

*Presented to*

## Facements

The Small Business Innovation Awards program recognizes a quality that represents the pinnacle of the small business, entrepreneurial experience: the ability to develop products and services that are truly unique and serve a genuine market need. The Awards, now in their seventh year, are sponsored by the Small Business Association of Michigan, Small Business Foundation, Fifth Third Bank, The Detroit News, Michigan State University, Office of Intellectual Property, and The Lansing Community College Small Business Development Center.

June 26, 2003



*Gay M. Woodbury*  
Gay M. Woodbury, President & CEO

*Michael W. Rogers*  
Michael W. Rogers, Vice President of Communication

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Applicant : Richard W. Nykamp  
Serial No. : 10/628,963  
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X. Related Proceedings Appendix

Attached behind this page is a copy of the decision rendered by the Board in the Appeal in the parent application, which decision is identified in Section II above pursuant to 37 C.F.R. 41.37(c)(1)(ii).

SEP 01 2005

REC'd 76270-001

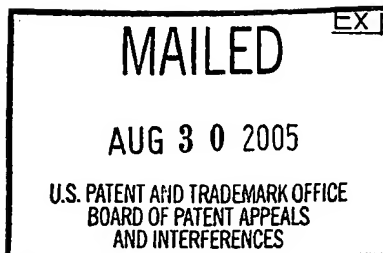
CHARLES E. BURPEE

The opinion in support of the decision being entered today was not written  
for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte RICHARD W. NYKAMP and DAVID A. STEIL



Appeal No. 2005-1709  
Application No. 09/999,400

ON BRIEF

Before MCQUADE, NASE and BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 8-10, which  
are all of the claims pending in this application.

BACKGROUND

The appellants' invention relates to decorative covers for office furniture  
(specification, page 1). Independent claim 9 is representative of the invention and  
reads as follows:

9. An article of office furniture comprising:  
a metal office furniture piece including a plurality of components each having dimensions, one of said components including a physical feature; and  
a plurality of magnetic decorative covers, each of said covers overlying and attached to one of said components, each of said covers having dimensions substantially the same as the dimensions of the component to which the cover is attached<sup>(1)</sup>, each of said covers comprising a magnetic sheet and a decorative material, the decorative cover attached to said one component defining a cutout aligned with said physical feature.

### ***The Applied Prior Art***

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Malino	5,799,423	Sep. 1, 1998
Blyden et al. (Blyden)	6,217,958	Apr. 17, 2001

### ***The Rejection***

The following rejection is before us for review.

Claims 8-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Malino in view of Blyden.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (mailed April 21, 2004) for the examiner's complete reasoning in support of the rejection

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<sup>1</sup> As illustrated in Figures 1 and 3 of the present application, each decorative panel has surface dimensions which are substantially the same as the dimensions of the face of the component to which it is attached. Thus, in accordance with the appellants' underlying disclosure, we interpret the "each of said covers having dimensions substantially the same as the dimensions of the component to which the cover is attached" limitation in claim 9 as requiring that each cover have surface dimensions which are substantially the same as the dimensions of the face of the component to which it is attached.

and to the brief (filed January 15, 2004) and reply brief (filed June 1, 2004) for the appellants' arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. For the reasons expressed below, we conclude that the teachings of the applied references are insufficient to establish a *prima facie* case of obviousness of the subject matter of the appellants' claims.<sup>2</sup>

Malino discloses a magnetic calendar which is magnetically held to a metal surface such as a refrigerator door or file cabinet, as illustrated in Figures 2 and 6. Malino's calendar is not disclosed as having dimensions substantially the same as those of the component to which it is attached, as called for in appellants' claim 9. In fact, the calendar is shown in Figures 2 and 6 to have substantially smaller dimensions than those of the component to which it is attached. Moreover, Malino's calendar lacks a cutout aligned with a physical feature of the component to which it is attached, as also called for in claim 9. As also recognized by the examiner, Malino discloses only a single calendar, not a plurality of magnetic decorative covers each overlying and attached to one of the components, as required by claim 9.

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<sup>2</sup> Accordingly, it is not necessary for us to specifically address the secondary considerations raised by the appellants on pages 12 and 13 of the brief.

Blyden discloses an ornamental device for a hood of a car comprising a first weather resistant layer having a design printed or placed thereon and a second layer having magnetic properties for attaching the device flatly and firmly to the hood of a car to decorate the car. Blyden's teachings are expressly limited to an ornamental device for the hood of an automobile (column 1, lines 11-18, and column 5, lines 5-20) and are in no way directed to office furniture. Accordingly, Blyden would not have provided any suggestion to one of ordinary skill in the art to modify the dimensions of the calendar of Malino to substantially correspond to those of the component of furniture to which it is attached.

Furthermore, Blyden provides no teachings with regard to a cutout aligned with a physical feature of the component to which the ornamental device is attached. The examiner's statement, on page 6 of the answer, that "it would be obvious to provide a cutout to avoid covering the handle and rendering the furniture useless" is not well taken, as it presumes that one of ordinary skill in the art would have been led by the teachings of Malino to place the calendar at a location on the furniture, such as the front face of a file cabinet drawer or a refrigerator door, such that it would, without a cutout, overly a handle and Malino provides no such teaching or suggestion.

As should be apparent from the foregoing, we fail to perceive any teaching, suggestion or incentive in the applied references which would have motivated an artisan to modify Malino in such a fashion as to meet the terms of claim 9. From our perspective, the only suggestion for the modifications proposed by the examiner is

found in the luxury of hindsight accorded one who first viewed the appellants' disclosure. This, of course, is not a proper basis for a rejection. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). The rejection of claim 9, as well as claims 8 and 10 which depend therefrom, as being unpatentable over Malino in view of Blyden is reversed.

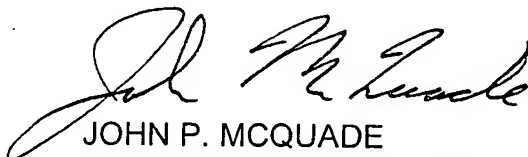
#### CONCLUSION

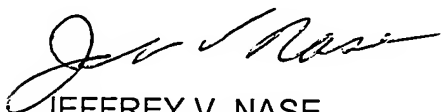
To summarize, the decision of the examiner to reject claims 8-10 under 35 U.S.C. § 103 is reversed.



No time period for taking any subsequent action in connection with this appeal  
may be extended under 37 CFR § 1.136(a).

REVERSED

  
JOHN P. MCQUADE  
Administrative Patent Judge

  
JEFFREY V. NASE  
Administrative Patent Judge

  
JENNIFER D. BAHR  
Administrative Patent Judge

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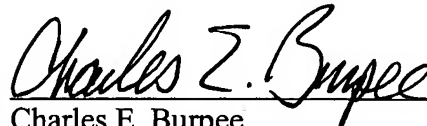
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In summary, the Examiners' rejections under 35 U.S.C. 102(b) and 103 are improper and/or unfounded, and should be reversed. The strong evidence of secondary considerations supports the requested reversal.

Respectfully submitted,

RICHARD W. NYKAMP ET AL

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